

REMARKS

In light of the amendments to the application noted above and remarks to follow, reconsideration and allowance of the above-referenced application are respectfully requested.

It is submitted that these claims, as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 USC §112. Changes to these claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

Amended claims 1 and 53-143 are in this application. Claims 284-289 are newly added.

At paragraph 2 of the outstanding Office Action of November 4, 2003, the Examiner rejected claims 1, 68, 83, 99, 114 and 129 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner stated that the limitation “within an original display” of claim 1 is not supported in the specification. Claim 1, as well as claims 68, 83, 99, 114 and 129 have been amended by clarifying what is meant by “within an original display.” Applicant has made the amendments as requested by the Examiner and therefore requests that the rejection to these claims under 35 U.S.C. 112, first paragraph be withdrawn.

At paragraph 3 of the outstanding Office Action of November 4, 2003, the Examiner rejected claims 1, 62, 68, 83, (presumably 93), 99, (presumably 109), 114, (presumably 124), 129 and presumably 139 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that the limitation "within an original display" of claims 1, 68, 83, 99, 114 and 129 is unclear as to what the original display is referring to. Claims 1, 68, 83, 99, 114 and 129 have been amended by clarifying what is meant by "within an original display." Further, the Examiner stated that the limitation "said new advertisement data" of claims 62 and 93 is unclear as to what new advertisement data the applicants are referring to. Claims 62 and 93 have been amended by clarifying what is meant by "said new advertisement data." In addition, the Examiner stated that claims 62, 93, 109, 124 and 139 recite the phrase "may be" which renders the claims indefinite. This phrase has been removed from these claims. Applicant has made the amendments as requested by the Examiner and therefore requests that the rejection to these claims under 35 U.S.C. 112, second paragraph be withdrawn.

At paragraph 5 of the outstanding Office Action of November 4, 2003, the Examiner rejected claims 1, 53-57, 59-60 and 62-143 under 35 U.S.C. § 103(a) as being unpatentable over Reilly et al. (U.S. Patent No. 5,740,549) in view of Pirani et al. (U.S. Patent No. 5,105,184). Applicant respectfully traverses the rejection.

Amended independent claim 1, recites in part, "An apparatus for executing an executable program...comprising... means for receiving new advertising data on a recurring basis..." (Underlining and Bold added for emphasis.)

The Examiner admits that Reilly fails to disclose, "an original display data generated by said executable program." The Examiner then relies on Pirani to overcome the deficiencies of Reilly. However, Pirani's disclosure does not overcome the deficiencies of Reilly. Pirani does not teach or suggest the additional limitation of amended independent claim 1.

Pirani discloses commercial advertisements to be placed in different parts of computer software so that these ads become an integral part of such software (column 6, lines 22-28). However, Pirani does not disclose a means for receiving new advertising data on a recurring basis, as does amended independent claim 1. As can be seen in figures 1A, 1B, 2A and 2B of the present invention, different commercial advertisements are displayed in predetermined positions or traditional advertising locations in an executable program, which are updated on a recurring basis. For instance, these ads are displayed on a billboard or on the clothing of a racecar driver and can be updated, for example, each time a user uploads the executable program. Indeed, this is not the case in Pirani who merely displays an advertisement on a screen of an executed software program that is not updated with new recurring advertisements. Therefore, amended independent claim 1 is believed to be distinguishable from the applied combination of Reilly and Pirani.

For similar reasons described above, it is also believed that amended independent claims 68, 83, 99, 114 and 129 are also distinguishable from the applied combination of Reilly and Pirani as applied by the Examiner.

Applicant therefore respectfully requests the rejection of claims 1, 53-57, 59-60 and 62-143 under 35 U.S.C. §103(a) be withdrawn.

At paragraph 6 of the outstanding Office Action of November 4, 2003, the Examiner rejected claim 58 under 35 U.S.C. § 103(a) as being unpatentable over Reilly et al. (U.S. Patent No. 5,740,549) in view of Pirani et al. (U.S. Patent No. 5,105,184) as applied to claim 1 and further in view of Handelman (U.S. Patent No. 5,539,450). Applicant respectfully traverses the rejection.

Claim 58 depends from amended independent claim 1 and, due to such dependency, is also believed to be distinguishable from Reilly and Pirani for at least the reasons previously described. The Examiner did not rely on Handelman to overcome the above-identified deficiencies of Reilly and Pirani. Therefore, claim 58 is believed to be distinguishable from the applied combination of Reilly, Pirani and Handelman.

Applicant therefore respectfully requests the rejection of claim 58 under 35 U.S.C. §103(a) be withdrawn.

At paragraph 7 of the outstanding Office Action of November 4, 2003, the Examiner rejected claim 61 under 35 U.S.C. § 103(a) as being unpatentable over Reilly et al. (U.S. Patent No. 5,740,549) in view of Pirani et al. (U.S. Patent No. 5,105,184) as applied to claim 1 and further in view of Hornbuckle (U.S. Patent No. 5,497,479). Applicant respectfully traverses the rejection.

Claim 61 depends from amended independent claim 1 and, due to such dependency, is also believed to be distinguishable from Reilly and Pirani for at least the reasons previously described. The Examiner did not rely on Hornbuckle to overcome the above-identified deficiencies of Reilly and Pirani. Therefore, claim 61 is believed to be distinguishable from the applied combination of Reilly, Pirani and Hornbuckle.

Applicant therefore respectfully requests the rejection of claim 61 under 35 U.S.C. §103(a) be withdrawn.

Applicant has further added new claims 284-289. Applicant submits that the 35 U.S.C. 103(a) rejections relied upon by the Examiner do not apply to claims 284-289, and submits that the rejection of these claims over 35 U.S.C. 103(a) would be improper.

The Examiner has made of record, but not applied, several U.S. Patents. The Applicant appreciates the Examiner's explicit finding that these references, whether considered alone or in combination with others, do not render the claims of the present application unpatentable.

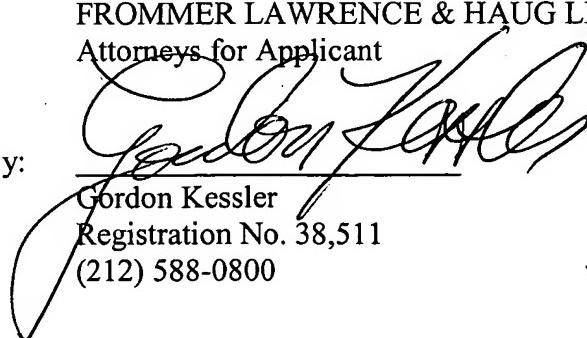
It is to be appreciated that the foregoing comments concerning the disclosures in the cited prior art represent the present opinions of the applicant's undersigned attorney and, in the event, that the Examiner disagrees with any such opinions, it is requested that the Examiner indicate where in the reference or references, there is the bases for a contrary view.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By:


Gordon Kessler
Registration No. 38,511
(212) 588-0800